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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,717	01/06/2005	Hideyoshi Yoshimura	62,669 (48882)	2582
21874	7590	11/06/2007		
EDWARDS ANGELL PALMER & DODGE LLP			EXAMINER	
P.O. BOX 55874			TRAORE, FATOUMATA	
BOSTON, MA 02205			ART UNIT	PAPER NUMBER
			2136	
			MAIL DATE	DELIVERY MODE
			11/06/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/520,717

Applicant(s)

YOSHIMURA, HIDEYOSHI

Examiner

Fatoumata Traore

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 06/04/2007, 01/06/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response of the original filing of January 6<sup>th</sup>, 2005. Claims 1-6 are pending and have been considered below.

#### ***Claim Objections***

2. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 6 is a product claim (i.e. computer-readable media) that refers back to Claim 5. The Office considers any claim that refers to another claim as dependent thereon, i.e. a dependent claim. Since Claim 5 is a program claim comprising four steps and Claim 6 fails to add, delete, or change any of these steps, Claim 6 fails to further limit its parent claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 5 is drawn to a computer program per se. A computer program is not a series of steps or acts and this is not a process. A computer program is not a physical article or object and as such is not a machine or manufacture. A computer program is not a combination of substances and therefore not a compilation of matter. Thus, a

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computer program by itself does not fall within any of the four categories of invention.

Therefore, Claim 5 is not statutory.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Squilla et al (US 5,898,779) in view of Pavlik (US 6,807,633).

***Claims 1, 3, 4, 5, and 6:*** Squilla et al discloses an anti-tampering signature method, apparatus, system, program and computer readable for rewritable media wherein display data displayed on a rewritable medium that displays display data stored in a writeable and erasable state is certified (*authenticated*) (abstract), the method comprising:

- i. An extraction step of extracting a characteristic quantity from image data that is generated by reading the display data according to an instruction from a certifier, who has certified the display data (Fig. 5, steps S201 and S202),
- ii. A data generation step of generating encrypted data by encrypting the characteristic quantity using an encryption key paired with an identifier (*the image hash is then encrypted with the embedded private key, thereby*

*producing a digital signature uniquely associated with said active area of the image*) (column 3, lines 14-18; column 6, lines 31-40; column 7, lines 1-8; Fig. 5, step 78 and Fig. 7, step 78),

iii. An appending step of appending the identifier (*hash value*) and the encrypted data to the rewritable medium (Fig. 5 step 80 and Fig. 7 step 80), and

But does not explicitly disclose that a judgment step of obtaining the encryption key based on the identifier according to an instruction of a verifier who verifies a certificate and judging whether or not the characteristic quantity obtained by decrypting the encrypted data, and the characteristic quantity of the display data match. However, Pavlik discloses a digital signature method, apparatus, system, program, and computer readable medium, which further disclose that the judgment step of obtaining the encryption key based on the identifier according to an instruction of a verifier who verifies a certificate and judging whether or not the characteristic quantity obtained by decrypting the encrypted data, and the characteristic quantity of the display data match (*after the digital certificate is authenticated, the document recipient decrypts the digital signature attached to the electronic document using the public encryption key included with the digital certificate, applies the hash algorithm to the electronic document, and then compares the data word returned from the hash algorithm with the hashed data word extracted from the digital signature of the electronic document. If the hash values match, then the document recipient has verification that the electronic*

*document originated from the named originator, and was not altered during transmission by third parties)* (column 1, lines 64 to column 2 line 17).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to obtain the encryption key based the identifier according to an instruction of verifier in Squilla et al's disclosure. One would have been motivated to do so in order to allow the recipients of electronic documents to verify the authenticity of the electronic document as disclosed by Pavlik (column 1, lines 29-35).

**Claim 2:** Squilla et al and Pavlik disclose an anti-tampering signature method for rewritable media according to claim 1 above, and Squilla et al further discloses that in the extraction step, a general characteristic extracted (*the region of interest*) from the image data generated by reading the display data is used as the characteristic quantity (*the region of interest in the camera is selected by the user either by choosing a template from a number of pre-stored templates or by selecting areas on a displayed grid on an external LCD screen or an electronic viewfinder*) (column 3, lines 19-34; Fig. 1B and 1C).

### **Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hung US 2006/0041760 Trusted computer activity monitoring and recording system and method.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fatoumata Traore whose telephone number is (571) 270-1685. The examiner can normally be reached Monday through Thursday from 7:00 a.m. to 4:00 p.m. and every other Friday from 7:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nassar G. Moazzami, can be reached on (571) 272 4195. The fax phone number for Formal or Official faxes to Technology Center 2100 is (571) 273-8300. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 270-2685.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-2100.

FT  
Tuesday October 30<sup>th</sup>, 2007

Nassar G. Moazzami  
Supervisory Patent Examiner

  
11/2/07